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09/715,641

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Robert D. Haskins

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EXAMINER

DENNISON, JERRY B

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/715,641	Applicant(s) HASKINS ET AL.	
	Examiner J. Bret Dennison	Art Unit 2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 18-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16, and 18-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

RESPONSE TO AMENDMENT

1. This Action is in response to the Amendment for Application Number 09/715,641 received on 12/11/2007.
2. Claims 1-16, and 18-31 are presented for examination.
3. Claims 29-31 are newly added claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-16 and 18-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stark et al. (U.S. 2003/0233420) in view of Barchi (U.S. 6,507,866).
5. Regarding claims 1, 2, 12, 14, 15, and 26-29, Stark disclosed a method for controlling transmission of messages from an originator computer system, the method comprising the steps of:
 - detecting an outbound message from an originator computer system (Stark, [0048], Stark disclosed a MessageML Service detecting an outbound message from a sender); and
 - verifying an authenticity of an originator identity associated with the outbound

message by comparing a mapping of network addresses with account names such that the originator identity associated with the outbound message is associated with a valid account name and network address pair (Stark [0048], Stark disclosed when the MessageML Service receives a message from a sender, the Service Provider checks the physical IP address and the account to verify that the IP address matches one of the entries in the Informant Stylesheet, and if a match is found, the message is considered authentic, otherwise, rejected; [0047] The Informant Stylesheet defines information about the Informant or sender of the information and its valid transport sources or locations from where it will send its messages, i.e. identity of originator).

Stark did not explicitly state performing a quota enforcement operation based on a message count and a message limit associated with an originator identity to produce a message transmission result; and

performing a selective transmit operation including at least one of:

- i) transmitting the outbound message onto a computer network if the message transmission result contains a transmit value; and
- ii) preventing transmission of the outbound message onto a computer network if the message transmission result contains a no transmit value

In an analogous art, Barchi disclosed tracking the originator of email messages with a field containing information identifying the originator of the received email message (Barchi, col. 8, lines 1-8);

performing a quota enforcement operation based on a message count associated with an originator and a message limit to produce a message transmission result

(Barchi, col. 6, lines 43-48, Fig. 5, 503-505, Barchi disclosed checking the message count against a threshold; col. 5, lines 59-63, Barchi disclosed detecting from a single user); and

performing a selective transmit operation including at least one of

- i) transmitting the outbound message onto a computer network if the message transmission result contains a transmit value; and
- ii) preventing transmission of the outbound message onto a computer network if the message transmission result contains a no transmit value (Barchi, col. 8, lines 10-32, Barchi disclosed setting a flag depending on whether the threshold has been exceeded, the flag being used to determine whether to prevent or allow transmission of the message).

The purpose for authenticating the sender of an email message in Starks is to prevent the use of the email system by malicious users. The purpose for the email usage pattern detection teachings of Barchi is to prevent malicious users from sending massive quantities of undesired email. Since both references teach acts of preventing unauthorized, malicious use of email systems (Starks, [0047]; Barchi, col. 3, lines 65-67), it would have been obvious for one of ordinary skill in the art at the time the invention was made to incorporate the email usage detection teachings of Barchi into the teachings of Starks in order to make sure that once a user's email is authenticated as coming from an original identity, that the user is not sending out massive amounts of undesired email, i.e. spam, for the benefit of providing extra protection against users abusing the email system, in order to reduce or eliminate the volume of undesired email

messages received by a computer system or server (Barchi, col. 1, lines 10-13).

Claims 12 includes a method with limitations that are substantially similar to the limitations of claim 1. Claims 14 and 26 include a computer system (Barchi, Fig. 9) with a database (Barchi, col. 6, lines 20-55) used to perform the limitations of claim 1. Claims 27 and 28 include a computer program product with limitations substantially similar to claim 1. Claim 29 includes a method with limitations that are substantially similar to the limitations of claim 1. Therefore, claims 12, 14, 26, 27 and 28-29 are rejected under the same rationale.

6. Regarding claims 3 and 16, Stark and Barchi disclosed the limitations, substantially as claimed, as described in claims 2 and 15, including wherein the step of comparing the message count associated with an originator identity of the outbound message includes the steps of.

obtaining an originator address associated with the outbound message (Stark, [0048]);

obtaining the originator identity associated with the outbound message by performing an originator identity lookup based on the originator address (Stark, [0048]); and

obtaining at least one message count associated with the originator identity by performing a message count lookup based on the originator identity (Barchi, col. 6, lines 38-50).

7. Regarding claims 4 and 17, Stark and Barchi disclosed the limitations, substantially as claimed, as described in claims 3 and 16, including wherein:

the step of obtaining an originator address includes retrieving a network address associated with the outbound message from a message connection establishment protocol used to transfer the outbound message from an originator computer system to a recipient computer system (Barchi, col. 8, lines 1-8);

the step of obtaining the originator identity includes the step of querying a login database containing mappings of originator addresses to originator identities based on the originator address obtained in the step of obtaining an originator address (Stark, [0048]); and the

step of obtaining a message count for the originator identity associated with the outbound message includes querying a quota database containing associations of message counts to originator identities based on the originator identity associated with the outbound message (Barchi, col. 6, lines 38-50); and

wherein the message count is at least one message count that indicates, for an originator identity, a current number of outbound message transmitted over an elapsed time interval (Barchi, col. 6, lines 38-50, col. 7, line 65 through col. 8, line 10); and

wherein the message limit is at least one message limit corresponding to a respective at least one message count that indicates, for an originator identity, a maximum number of outbound messages that may be transmitted over a predetermine time interval (Barchi, col. 7, line 65 through col. 8, line 10). See above for motivation.

8. Regarding claims 5 and 18, Stark and Barchi disclosed the limitations, substantially as claimed, as described in claims 2 and 15, including wherein the step of updating the message count associated with the originator identity of the outbound message includes the steps of calculating a total number of recipients for the outbound message and incrementing the message count associated with the originator identity by the total number of recipients for the outbound message (Barchi, col. 8, lines 1-45, Barchi discloses tracking recipients of email messages). See above for motivation.

9. Regarding claims 6 and 19, Stark and Barchi disclosed the limitations, substantially as claimed, as described in claims 2 and 15, including wherein the message limit indicates an amount of outbound messages that may be transmitted from the originator computer system over a certain period of time for the originator identity associated with the outbound message (Barchi, col. 8, lines 1-10, Barchi discloses a threshold for a period of time); and

wherein the originator identity of the outbound message is indicative of at least one of:

- a specific user account operating under control of a computer user;
- a specific message sending user; and
- a specific domain (Stark, [0048]).

10. Regarding claims 7 and 20, Stark and Barchi disclosed the limitations, substantially as claimed, as described in claims 2 and 15, including wherein:

the message limit condition indicates if a computer user account associated with

the originator identity used to transmit the outbound message is attempting to transmit a number of outbound messages that exceeds the message limit in a predetermined amount of time (Barchi, col. 7, line 65 through col. 8, line 8); and

wherein the message limit condition occurs if the step of comparing determines at least one of the message count exceeds the message limit (Barchi, col. 7, line 65 through col. 8, line 8); and

the message count is equal to the message limit (Barchi, col. 7, line 65 through col. 8, line 8) See above for motivation.

11. Regarding claims 8 and 21, Stark and Barchi disclosed the limitations, substantially as claimed, as described in claims 2 and 15, including wherein the quota enforcement operation includes the steps of:

verifying authenticity of at least one recipient associated with outbound message (Barchi, col. 8, lines 1-50). See above for motivation.

12. Regarding claims 9 and 22, Stark and Barchi disclosed the limitations, substantially as claimed, as described in claims 1 and 14, including wherein the step of performing a quota enforcement operation includes the step of:

comparing a previous message transmission result with a no-transmit value, and if the previous message transmission decision equals the no-transmit value, performing the step of performing a selective transmit operation (Barchi, col. 8, lines 1-45). See above for motivation.

13. Regarding claims 10 and 23, Stark and Barchi disclosed the limitations, substantially as claimed, as described in claims 1 and 14, including wherein the step of detecting an outbound message includes the steps of:

searching a quota enforcement list for an originator address associated with the message, and if the originator address associated with the message is contained in the quota enforcement list, performing the steps of performing a quota enforcement operation and performing a selective transmit operation, and if the originator address associated with the message is not contained in the quota enforcement list, skipping the step of performing the quota enforcement operation and performing the step of transmitting the outbound message from the computer system (Barchi, col. 8, lines 1-45). See above for motivation.

14. Regarding claims 11 and 24, Stark and Barchi disclosed the limitations, substantially as claimed, as described in claim 1, including the steps of:

authenticating a connection from the originator computer system (Stark [0048],);
recording authentication information in a login database, the authentication information including an originator address assigned to the originator computer system and an originator identity associated with the originator address (Stark [0047]-[0048],);
receiving, for transmission to a recipient computer system, the outbound message from the originator computer system (Stark [0048],);

forwarding the outbound message to a quota server to perform the steps of detecting an outbound message, performing a quota enforcement operation and performing a selective transmit operation (Barchi, col. 8, lines 1-45). See above for

motivation.

15. Regarding claim 13, Stark and Barchi disclosed the limitations, substantially as claimed, as described in claim 12, including wherein:

the at least one message count includes a first message count and a second message count (Barchi, col. 8, lines 1-45);

wherein the at least one message limit includes a first message limit and a second message limit (Barchi, col. 8, lines 1-45);

wherein in the step of comparing, the first message count is compared to the first message limit to determine if the first message count exceeds the first message limit in which case the message transmission result is set to a no-transmit value (Barchi, col. 8, lines 1-45); and

wherein in the step of comparing, the second message count is compared to the second message limit to determine if the second message count exceeds the second message limit in which case the message transmission result is set to a no-transmit value (Barchi, col. 8, lines 1-45).

16. Regarding claim 25, Stark and Barchi disclosed the limitations, substantially as claimed, as described in claim 24, including wherein the port redirector is a data communications device capable of directing outbound messages based on content contained within the outbound message, and wherein when the port redirector receives an outbound message that is to be subject to message quota enforcement based upon

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content contained with the outbound message, the port redirector forwards the outbound message to the quota server (Barchi, col. 8, lines 1-45). See above for motivation.

17. Regarding claim 30, Stark and Barchi disclosed the limitations, substantially as claimed, as described in claim 29, including

buffering, for later transmission onto a computer network, a number of copies of the outbound message equal to a difference between a total number of recipients for the outbound message and the number of recipients to which the outbound message is transmitted (Barchi, col. 4, lines 56-67, Barchi disclosed receiving email messages and analyzing fields of the email messages, thereby requiring buffering such messages); and

incrementing the message count associated with the originator identity by the total number of recipients for the outbound message (Barchi, col. 5, lines 1-10).

18. Regarding claim 31, Stark and Barchi disclosed the limitations, substantially as claimed, as described in claim 29, including incrementing the message count associated with the originator identity by the number of recipients to which the outbound message was transmitted (Barchi, col. 4, lines 60-67).

Stark and Barchi did not explicitly state discarding any copies of the outbound message not transmitted onto a computer network to a recipient.

However, Barchi clearly suggests using the features of the invention to reduce or

eliminate the volume of undesired email messages received by a server (col. 1, lines 10-13). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include as one of the Alarm modes of Barchi the discarding of email messages that exceed the threshold for the sender in order to successfully reduce or eliminate the volume of undesired email messages (col. 1, lines 10-13).

Response to Arguments

Applicant's arguments filed 12/11/2007 have been fully considered but they are not fully persuasive.

In response to Applicant's argument that Stark does not teach or suggest an enforcement mechanism for spamming, Examiner notes that Stark was not relied upon for the enforcement mechanism of the claimed invention. Barchi was relied upon for the enforcement mechanism.

In response to Applicant's argument that Barchi does not teach or suggest a mechanism for applying the enforcement mechanism to the originator identity, Examiner notes that Stark was relied upon for the correspondence between originator identity and the address of the email.

Applicant asserts, "Stark and Barchi are not even properly combinable" and that "Barchi teaches away from the present invention" [See Applicant's Response, page 18, last paragraph]. Applicant's asserts that the teachings of Barchi operate on received emails and that the present invention "operates on outbound messages" [See

Applicant's Response, page 19, first paragraph].

Examiner respectfully disagrees.

Examiner would like to point out that it is clear from Figure 1 of Applicant's invention that the "Message Quota System" 120 receives email messages from an Originator at element 105. The "Message Quota System" is an intermediary between sender and receiver. It is clear from Figure 1 and its related portions of Applicant's Specification that the Message Quota System receives an email message from an originator, analyzes the message, and determines whether to send the message on to the recipient based on rules. Applicant's specification states, "Disposed between the originator computer system 105 and the computer network 130 is a message quota system 120 configured according to the embodiments of the invention to limit the number of outbound messages 110 that the originator computer system can transmit onto the computer network 130" [See Applicant's Specification, page 16, lines 11-15]. **Therefore, Applicant's invention is performed at an intermediary.** The intermediary would have to first receive the message, and then analyze it, and send if it follows the rules.

Second, Examiner would like to point out that there are numerous portions of Barchi that disclose the teachings to be performed at an intermediary, in the same manner as Applicant's invention. For example, the teachings of Barchi begin with the following: "The present invention relates to methodologies for detecting patterns in received e-mail messages on a computer system" (Barchi, col. 1, line 4-6). Barchi then disclosed, "Detection of an undesired pattern of e-mail messages is the first step in

reducing or eliminating the volume of undesired e-mail messages received by a computer system or server. Once detection is accomplished, a policy can be set on the computer system or server to filter out the sources or types of e-mail messages. Therefore, from this citing, it is clear that the detection functionality is performed at a server between sender and receiver. **As such, the teachings of Barchi are performed at an intermediary, i.e. a mail server.**

Barchi disclosed, "The embodiment is a computer program designed to analyze all incoming e-mail messages and detect high frequency e-mail either originating from a single user or destined to a single user" (Barchi, col. 5, lines 59-62. Therefore, the teachings of Barchi not only monitor email destined to a recipient, but also monitor email originating from a single user. **From this it is clear that these teachings of Barchi occur at an intermediary.**

Applicant states, "Barchi teaches protecting 'the receiving e-mail system not only against malicious users, but also against such events as routing accidents.'" Applicant asserts, "Barchi can only protect against routing accidents if the mechanism is employed at the receiving end, after emails have been routed" [See Applicant's Response, page 18, second paragraph].

Examiner strongly disagrees.

In order for the teachings of Barchi to protect the receiving end from routing accidents, the **teachings would have to be performed somewhere other than the receiving end**. Otherwise, the receiving end would receive all the mistakenly routed

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emails. Examiner agrees that Barchi can only protect from routing accidents "after the emails have been routed", however, such protection cannot occur at the receiving end. It clearly occurs between sender and receiver, i.e. an intermediary, such as the disclosed "server" as shown above. The server receives an email message, determines that it is mistakenly routed, and does not route the message to the recipient, thereby protecting the recipient from the routing accident.

Applicant asserts, "The present invention, although providing benefits absent in Barchi, does not provide protection against routing accidents. This is because the present invention operates at the sending end, before emails are transmitted or routed" [See Applicant's response, page 18, second paragraph].

Examiner strongly disagrees.

As shown above, it appears that Applicant's invention is performed at an intermediary, between sender and recipient (See Figure 1 of Applicant's invention). Since The Message Quota System operates in the middle of sender and receiver, the Message Quota System first receives an email message from an originator. Therefore, Applicant's invention does not occur at the sending end.

Therefore, it appears that Applicant may have misinterpreted both the claimed invention as well as the prior art references. Since the relied upon portions of both Stark and Barchi occur at an intermediary, Applicant's assertions about features being destroyed would not occur.

It is the Examiner's position that Applicant has not yet submitted claims drawn to

limitations, which define the operation and apparatus of Applicant's disclosed invention in manner, which distinguishes over the prior art.

Failure for Applicant to significantly narrow definition/scope of the claims and supply arguments commensurate in scope with the claims implies the Applicant intends broad interpretation be given to the claims. The Examiner has interpreted the claims with scope parallel to the Applicant in the response and reiterates the need for the Applicant to more clearly and distinctly define the claimed invention.

Conclusion

Examiner's Note: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds

of the claimed invention.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Bret Dennison whose telephone number is (571) 272-3910. The examiner can normally be reached on M-F 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/J. D./

Examiner, Art Unit 2143\

/Nathan J. Flynn/

Supervisory Patent Examiner, Art Unit 2154